

REMARKS

With reference to the Claims:

Amendment of **Claim 1**:

To provide consistency with other portions of the disclosure;
deletion of "spring-biased" as a limiting term for consistency with disclosure
addressing possible alternative camming arrangements and to meet Examiner's
directive with reference to absence of antecedent precedent in claims

Amendment of **Claim 2**:

To avoid redundancy and meet Examiner's holding with reference
to use of alternative expression

Amendment of **Claim 4**:

To make expression positive to meet Examiner's holding

Cancellation of **Claim 13**:

Corrected and rewritten as **Claim 16**

Addition of **Claim 15**:

To account for possible limitation to spring-biased arrangement in
view of appropriate antecedent precedent throughout disclosure

Addition of **Claim 16**:

Previous **Claim 13** rewritten to address incorrect claim dependency
reference and to delete superfluous language inadvertently included in original
draft

With reference to the Disclosure of the Specification:

Substitution of paragraph **[0002]:**

To correct reference number and punctuation.

Substitution of paragraph **[0003]:**

To broaden expression for clarification; correct erroneous assembly constituent; indicate non-essentiality of linkage ring (23) as a component

Substitution of paragraph **[0004]:**

To supply missing reference numbers and tailor expression to more clearly indicate invention's broader application consistent with balance of disclosure

Substitution of paragraph **[0005]:**

To avoid redundancy of expression and supply missing reference numbers

Substitution of paragraph **[0006]:**

Same as **[0005]** concerning reference numbers

Substitution of paragraph **[0007]:**

Same

Substitution of paragraph **[0010]:**

To specifically denote most likely invention application

Substitution of paragraph **[0011]:**

Same as **[0007]**

Substitution of paragraph **[0014]:**

Punctuation and same as **[0006]** for reference number

Substitution of paragraph **[0016]:**

Same as **[0010]**

Substitution of paragraph **[0023]:**

Same as **[0007]**

Substitution of paragraph **[0026]:**

Same as **[0003]** with reference to erroneous assembly component

Substitution of paragraph **[0027]:**

Same; syntax; and to correct reference number

Substitution of paragraph **[0030]:**

Same, concerning reference number

Substitution of paragraph **[0032]:**

To clarify language susceptible to misinterpretation

Substitution of paragraph **[0035]:**

To correct spelling; delete erroneously included reference numbers and supply missing one; and clarify spring biased embodiment merely as an alternative one

Substitution of paragraph **[0036]:**

Same as **[0032]**

Substitution of paragraph **[0037]**:

Same as **[0035]** with reference to clarification

Substitution of paragraph **[0038]**:

To correct erroneous component reference for consistency with balance of disclosure and drawings; typo; and supply missing word

Substitution of paragraph **[0042]**:

Same as **[0007]**

Substitution of paragraph **[0047]**:

Same as for **[0010]**

With reference to the Drawings:

The changes to the drawings are adequately explained in the appended *Letter to Chief Draftsperson*.

AMENDMENT'S EFFECT UPON THE NUMBER OF CLAIMS

The number of independent claims is unchanged, remaining at two, but the total number of claims has increased from 14 to 15.

ARGUMENT

Amendment may have made some issues moot. The essential or more material content of the application is addressed under the non-obviousness test of Sec. 103 of USC Title 35.

I.

Citing U.S. Patent No. 6,322,483 issued to *Rotella* in view of U.S. Patent No. 4,477,947 issued to *Lyons*, The Examiner rejected both independent claims herein—one comprising product recitals, the other, a method. Applicant is unaware of any authority which would simultaneously make applicable a non-obviousness dual reference—that is, one in view of another—for both species of claims. That would seem to be possible only if the two were held to portray *process by product* phenomena. Then, one could say that they really amount to one and the same and, *ipso facto*, vulnerable to the same ordinances. However, unless the Examiner's description of the method claim as "inherently within the scope" (page 4, lines 6 and 7 of the action) means otherwise, it does not appear he so ruled; and, while it may be thought never too late to do so, the very first office action really would seem the more professional occasion for it.

Although it is true non-obviousness considerations, when not diligently corralled, have been known to lapse at times into somewhat nebulous subjectivity, jurists have vigorously affronted that tendency, demanding the disciplined application of truly objective standards. The Examiner properly began his recitals with the nearly universally trumpeted *Graham v John Deere Co.*, 383 U.S. 1, 148USPQ 459 (1966). Although the discussion which follows in ostensible application of the case is reasonably lengthy, Applicant fails to see how the criteria specifically apply to the subject matter herein.

Rotella illustrates merely a door (200) encircling cam-buckled strap upon which small strap loops provide selectable tethers for a stretchable cord (552). *Lyons* features paired components comprising interior saw-tooth configuration

with a singular drawstring for waist encircling attire—pants, trunks, shorts and the like. The saw-teeth of buckle components trap the ends of the drawstring reeved, respectively, through each buckle. It is appropriate and only fair to concede the benefit of a doubt and consider the *Lyons* buckles on par with those of Applicant. After all, they are similarly oriented with their free sliding faces set together with what should be their respective tethering and their impinging ends pointing in the same direction. The Examiner is entitled to considerable credit for having unearthed this useful reference, particularly in a field of inquiry quite distant from that of the subject matter hereof.

For purposes of comparison, however, the arrangement is not complete. Applicant's assembly comprises not one but two independent leads—an object strap (22) and a door enwrapping one (100). One is routed through both tethering ends and the other, through both impinging ends. The difference may not immediately register with some and that, of course, is what is so material to its novelty. The routing of each lead end in *Lyons* is similar to that which would be employed with a singular cam buckle (21). Hypothetically granting *Lyons* two cam buckles (21), one at each respective end of the lead, his drawstring--considered in equivalence to a strap--is routed through longitudinally in the familiar manner strap and tooth buckling had been done for, perhaps, a century. *Lyons* would surely be the first to declare he did not seek and obtain his patent for that but, rather, for the clever way in which the companion buckles could so easily be tugged apart. That then novel concept had its place and could still be advantageously adopted even today in the apparel market.

But those strap routing concepts—that of the long-standing prior art even before *Lyons* and that of Applicant—must not be confused. Applicant would have, indeed, welcomed an example from some prior-century farmer who might have tied his load in the fashion offered herein. Even then, the subject matter hereof could conceivably comprise a proper revival of an ancient art but more likely, Applicant would have been spared considerable time and expense. But no such

reference has surfaced—neither from Applicant or the Examiner. The strap routing is almost everything. As the application discloses, it does not appear that any other sort of routing could provide the adjustable bi-directional non-slippage featured. Unless a buckle is configured with very sharp pointed teeth—sawteeth, as it were—the so-called “locking” characteristic of prior art has been in only one direction. As fervently explained in the application, Applicant’s arrangement locks the buckling pair in both directions.

There is also the matter of reference proximity to consider. Where, thus, *A*’s offering is evaluated against *B*’s device *in view of C*’s, to successfully establish obviousness, what *A* provides should be more closely associated with that of *B* than *C*’s is with that of *B*. The thinking is roughly that if *B* would have provided the sought after feature if he or she knew of *C*’s works, then certainly he would have done so *vis-a-vis* that of *A*. One need not strain to see that the *Rotella* and *Lyons* assemblies are fairly distant one another. By reason of the very special arrangement by which the opposing cam-buckles (21) permit quick adjustment in either of two primary directions but as well provide bi-directional locking, applicant’s assembly is more remote that of either of those two references than they are from one another.

As the *Appendix* hereto discloses, among the applicable criteria are level of technical experience required to create the invention and the degree of parallel or related development activity. It is nearly inconceivable that during the long period of strapping usage in factories and on farms, particularly during the industrial and agricultural revolutions of the two most recent centuries, nobody seems to have come up with Applicant’s quick adjust, non-slip arrangement simply by fitting commonly available known parts together in a particular manner. Almost no expertise would have been needed to develop it—naught but a protracted effort of study and analysis of the way in which straps and buckles act upon one another. Any layperson--indeed. even a child--could have found this out by toying with the components over the kitchen table.

But can one honestly suggest *Rotella* would have conceived of Applicant's strap routing simply by an awareness of *Lyons*? Not very likely. If centuries of rural opportunity bore no fruit, why should *Rotella*'s efforts suddenly do so? In that respect, the configuration and use to which the cited devices were dedicated would neither generate any *inferences* the Examiner suggests might be relevant. Reliance upon *inference* here is really no different here than it is in court, as where a jury is permitted to *infer* certain facts to assist it in arriving at its findings. What Applicant states here is equally valid whether novelty ascertained through the prior art were subtly developed through inferences or by directly proven factual evidence. Applicant doubts the Examiner has suggested that *Rotella* either inferred or would have inferred the subject matter here from an acquaintance of *Lyons*' work if he, for some reason, might not have observed the phenomena directly. Could *Rotella* be credited with declaring, "Say, I think there are some inferences arising from *Lyons*' arrangement which I could use in mine—for instance, I might use two leads or straps even though *Lyons* has only one. Then maybe, I'll have a system that adjusts and locks in both directions. After all, such an arrangement would only be *a matter of design choice*." In fact, it is doubtful *Lyons* provides any inferences at all. Applicant believes everything that is material in *Lyons* is readily observable. There are no inferences to address. The Examiner cited none. The propositions addressing *inferences* in *In re Preda*, 401 F2d 825, 826, 159 USPQ 342, 344 (CCPA 1968) are not really new—merely a trial lawyer's stock in trade as it were. I know how it is in administrative review. When I held hearings I, too, would often dredge up all of the stock uniform phrases which had been stored for the purpose so as to be sure nothing was left out—especially if I had a heavy work load to contend with as Patent Examiners do. But whether the venture will be conducted with facts or inferences thereof in mind—whichever is preferred—Applicant encourages the Examiner to peruse the non-obviousness cases in the *Appendix* hereof.

II.

The Examiner indicated that dependent **Claims 3 - 10, 12 and 13** were separately rejected by adopting U.S. Patent No. 4,544,155 issued to *Wallenbrock* as an additional *in view of* reference. There is a further separate rejection of the last two of these with U.S. Patent No. 4,090,706 issued to *Reda* asserted as an *in view of* reference.

One of the application's dependent claims, **Claim 11**, was never addressed. That must have been an oversight, likely having been intended to fall within one or the other of the last two separate rejections.

Aside from the **Claim 11** question and the handling of the method claim above, the action reflects a substantial departure from appropriate or at least, what Applicant would consider customary procedure. There seems to be a failure to address the characterization of claims as independent or dependent. Considering the rush of pressure the Patent Office has been under for several months now in dealing with back-loads of work, it is not altogether unexpected that certain legal and administrative principals might escape attention. The signatory of this Office Action did not become a Primary Examiner without more than a modicum of learning and experience. That much is clear from the astute research undertaken. With all due respect, and we say that with sincere submission, a second look at the chain of reasoning would surely be worthwhile. Accordingly, Applicant sets forth the following propositions knowing they are already in the Examiner's store of knowledge. Please, therefore, take no offense.

A dependent claim inherently comprises all of the limitations of the independent claim it derives from. If an independent claim is successfully undermined, all claims depending from it automatically fall with it. If, for example, an independent claim is for *a water bucket* and a claim offered as a dependent one adding that the *water bucket additionally comprises a handle*, a holding that the independent claim is, for some reason invalid—nothing more being said to salvage the dependent claim by redrafting—the dependent claims also lose their efficacy. More specifically, if the independent claim is rejected,

say, under either Sec. 102 or 103, every claim dependent upon it must also fall.

It would, therefore, not be correct to recite that **Claim 1** and **2** are rejected under *Rotella* in view of *Lyons* but, rather, to say that **Claim 1** is rejected under *Rotella* in view of *Lyons* and that all claims dependent upon **Claim 1** are also thereby rejected. Herein, that would include **Claims 1 - 13**. To be precise, although Applicant disputes the method holding is incorrect, it appears to be the Examiner's intention to say that **Claims 1** and **14** are rejected under *Rotella* in view of *Lyons* and that all claims dependent upon those two claims are also thereby rejected. Herein, that would include all of the claims.

Then, it becomes at least superfluous to deal with **Claims 3 - 10** (Applicant, incidentally, believes the Examiner meant **Claims 3 - 11**--but no matter), if not fundamentally incorrect. All of those claims include all of the limitations of **Claim 1**. If the Examiner was correct concerning **Claim 1**, **Claims 3 - 11** need not--indeed, should not--be further addressed. There is nothing you can say about **Claims 3 - 11** which should not also be said against **Claim 1**. This is so because **Claim 1** is broader than **Claim 3**. Thus, in the example provided above, a claim for *a water bucket* is broader than a claim for *a water bucket with a handle*. Every time a claims writer opens his or her mouth to add something to a dependent claim, the legal efficacy of that claim is diminished, not enlarged.

If, on the other hand, the Examiner was incorrect concerning **Claim 1**, Applicant really should not care what the Examiner says against **Claims 3 - 11** because if **Claim 1** is awarded, there is not reason to worry about **Claims 3 - 11**. **Claim 1** is broader than them and despite the absence of those dependent claims, contains everything Applicant seeks. Otherwise stated, if Applicant successfully convinced the Examiner that **Claim 1** should be awarded because *Sec. 103* does not apply to it, cancellation of **Claims 3 - 11** would not be unfeasible. Applicant would have everything bargained for, so to speak, in **Claim 1**. Granted, it is useful to have dependent claims trailing after the

independent one to more clearly define what **Claim 1** already had. Thus, in the example, if the claim for *a water bucket* were allowed, the dependent claim for *a water bucket comprising a handle* could be withdrawn without detriment. By retaining the dependent claim, however, the reader is led to observe, "Oh, I see, **Claim 1** can be with or without a handle." It becomes just a matter of clarification. We both know, of course, that sometimes the broader claim must be lost because it goes too far, in which case the Examiner holds that the dependent claim would be allowed if redrafted to contain all of the limitations of the offered independent one. That is a different matter, however.

So, you don't first hold **Claim 1** invalid under a given *Sec. 103* proposition and then subsequently attack solely any of the claims dependent upon it. Thus, if **Claims 3 - 11** should fall by reason of *Rotella in view of Wallenbrock*, then **Claim 1**, upon which **Claims 3 - 11** are dependent must also fall by reason of *Rotella in view of Wallenbrock*. Again, you can't say anything against **Claims 3 - 11** which should not also be said against **Claim 1** because **Claim 1** contains everything that is in the dependent claims.

The same thing applies concerning the Examiner's handling of **Claims 12** and **13**. You can't say anything against **Claims 12** and **13** which should not also be said against **Claim 1**, upon which they are dependent.

Applicant has no desire of complicating the examination process by arguing these points as matters requiring correction to an already taken action—that is, effectually throwing a monkey wrench into the works. Instead, Applicant prefers to consider all three *in view of* references as being asserted against **Claims 1** and **14** and all claims respectively dependent upon either. That would seem to cover everything.

III.

For the foregoing reasons, *Wallenbrock*, the *in view of* reference held to undermine certain enumerated dependent claims, is considered with reference to **Claim 1**, upon which the enumerated claims were dependent. Because of what

has been said above, these points may be considered in connection with the enumerated claims, **Claims 3 - 11**. The dependent relationship between **Claim 3** and **Claim 1** is such that whereas the former is limited to use as exercise equipment, the latter is intended for possible uses beyond that, a proposition developed in the disclosure. In other words, there may be occasions to arrange for anchoring a tethered assembly in some respect—not necessarily a door—for some utilitarian purpose which could be exercise but which might be otherwise employed. For example, Applicant can imagine that a strapped assembly might be tethered to a tree and require upward or downward quick adjustment but which is securely locked in both directions. That would fall within the ambit of Claim 1. If the assembly were dedicated specifically to exercise and at a door wherein the two-way quick adjustment and bi-directional locking mechanism provides the tethering point against which to conduct exercises, that would be **Claim 3**. Since **Claim 1** encompasses **Claim 3**, as explained above, if *Rotella in view of Wallenbrock* were fatal to **Claim 3**, they would also have that result upon **Claim 1**. Well, certainly *Rotella* might have adopted the *Wallenbrock* linkages, perhaps as a distinct improvement to his own assembly. However, the Examiner attempts to read Applicant's assembly components upon those of *Wallenbrock* by saying that inventor teaches the use of *a strap interconnection adjusting assembly*. If by that, the Examiner means that Wallenbrock's device incorporates the *strap interconnection adjusting assembly* of Applicant's device, he is mistaken. Applicant's such assembly comprises an anchoring strap (1), an object strap (22) and a strap juncture adjusting assembly (2) comprising paired cam buckles (21). That is how Applicant defines *strap interconnection adjusting assembly*. Remember, an Applicant is his or her own lexicographer. *Wallenbrock* has none of those. He merely tethers a stretchable cord to an anchoring point in the wall. The most you can read from the one to the other, so far as this has taken us, is that both have an exercise tethering point (200, in applicant's case), dissimilar as they are. But that merely means the exercising

operator has an anchor of some sort to tug against.

The Examiner appears to misunderstand the intricacies of the application. He focuses upon *Wallenbrock's* miniature hook and loop fastening construction as means to fasten the stretchable cord to the operator. Applicant does not insist upon miniature hook and loop construction such as that disclosed by *Wallenbrock* to connect to exercise devices or other objects (500). For purposes of the application, Applicant is unconcerned what connection means are employed at that end of his assembly. Granted, Applicant does, in dependent **Claim 5**, designate miniature hook and loop construction as the loop securing means (104) upon the door enwrapping strap (100). **Claim 3**, however, upon which **Claim 5** is dependent provides for door mounting loop securing means (104) which may include miniature hook and loop construction or may comprise some other well known fastener. That connection, shown by a rectangle in **FIGs 3 - 5**, is deliberately left unspecified. So, you can't really read miniature hook and loop construction from Applicant's assembly upon that of *Wallenbrock*. Even if the connection of **Claim 3** had to be miniature hook and loop construction as in **Claim 5**, however, it is disposed to connect the door enwrapping strap (100), a member not present in *Wallenbrock's* assembly, and not the object strap (22) which might arguably be interpreted to apply to his stretchable cord by way of equivalence--a proposition Applicant would contest in any event. *Wallenbrock*, then, has no merit by way of an *in view of* reference. Had that reference incorporated a door enwrapping strap (100) with door-mount loop securing means (104) with miniature hook and loop fittings on the enwrapping strap (100), it might have been a different story. Then the Examiner might successfully attack **Claim 5** and, by way of indirection, **Claim 3**, were it an independent one. Since **Claim 3** is dependent, however, the reasoning above would have to apply. Loss of **Claim 3** would not be a tumultuous event, in any case, since if **Claim 1** were granted, Applicant would have that which he seeks and **Claim 1** might provide for a miniature hook and loop connection upon the

door connection strap (100) or it might with equal feasibility employ some other means.

IV.

We arrive at U.S. Patent No. 4,090,706 issued to *Reda* as an *in view of* reference directed by the Examiner against **Claims 12** and **13**. Ultimately--though different claims are addressed, dependent as they are, as well as different parts of the assembly--we must trundle down the same path of reasoning we invoked for *Wallenbrock*. The covering constructions of *Reda* might, it is true, have been adopted by *Rotella*, just as Applicant applied a buffering sheath (24) to the paired cam-buckles (21). A member of *Reda*'s assembly comprised a padded sleeve longitudinally enwrapping a stretchable exercise cord referred to in his patent as a "rubber band". Applicant believes the Examiner is stretching matters with respect to this *in view of* reference. *Reda* employed a covering to protect the lead--in his case, the stretchable cord. Applicant employs a covering to protect the door from impact by the cam-buckles (21). If that functional and structural difference is not readily apparent to the Examiner, Applicant is almost at a loss what to say. Where is the relevance?

V.

Where a combination type assembly is proffered for patenting, it is not enough to pick out one, two or possibly a few of its members and compare them one by one against prior art as *in view of* references. A combination may comprise many sub-components which may even be vulnerable to Sec. 102 anticipation--let alone Sec. 103 non-obviousness standards. That matters not so long as the assembly as a whole is novel or even so long as some of the members thereof are, themselves, novel so as to confer that characteristic of novelty upon the entire assembly. Can not a new invention have a prior art nail or screw as part of its structure? If that invention is otherwise novel, can one in good conscience bring it down it under Sec. 103 for failing to meet the non-obviousness test by reason of the nails or screws?

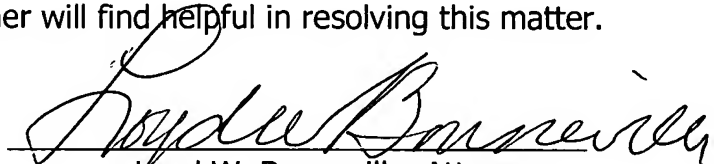
Applicant's assembly comprises paired cam-buckles (21) which permit both quick up and down or back and forth adjustment along the anchoring strap as well as bi-directional locking—that is, non-slippage in both directions. At the risk of being redundant, the disclosure clearly sets forth, singular cam-buckles (21) are prone to slipping in one direction regardless of how well they lock in the other. The principal appears to be new—indeed, is true, having found nothing to the contrary to this late point. The pairing of the cam-buckles (21) together with the unusual routing of the strapping provides all of the novelty one should need to clear the way to patenting.

VI.

There appear to be several deficiencies in the Office Action which, as indicated above, Applicant would concede to the rush of business and insufficient staffing. However, in the end, we must all recognize that it is not the mellowed cooperation of the Applicant which the reviewing authorities—the administrative appellate body or the courts themselves—rely upon. It has always been shown that the applicable rules are applied in a hard and fast manner. Applicant believes he has provided a novel assembly for the world to enjoy and the Examiner has countered his effort with inadequate *Sec. 103* references which in no way address the specific features of the assembly. Whatever Applicant's beliefs may be, he is not a prophet. What the Examiner has provided can help him very little in resolving the ultimate questions concerning his prospects for success. It appears the Examiner may have missed the point—and that has been known to happen from time to time. If it is otherwise, it should be clearly explained what there really is in the prior art which would preempt patentability. If there is anything, Applicant would like to know. If not, he has no wish to engage in diverse bantering about it. Applicant's manufacturing and marketing efforts—with or without limited monopoly protection—are, after all, the primary concerns of the *Dept. of Commerce* in this nation.

VII.

It is tempting to wonder whether the Examiner conceives of Applicant's assembly as too simple a construction to warrant the sought-after protection. We both know, of course, that a stroke of genius is not required to warrant patentability. Yet, simple non-technical breakthroughs do occur from time to time which properly belong to the first comer. One can always venture, "Oh, I would have thought of that, too." In keeping with the non-obvious criteria, applicant put together a collection of widely familiar articles to accomplish an end which presumably had not been done throughout history. No technical expertise was applied to the task, merely the fiddling around with or manipulation of commonplace objects much like the effort a sailor might undertake in tying a new knot. As mentioned above, anybody could have produced this unusual and unexpected result at least for the past 200 years—perhaps longer. Applicant has, accordingly, provided an *Appendix* of several cases herewith for reliable authority which he hopes the Examiner will find helpful in resolving this matter.


Loyd W. Bonneville, Attorney
Registration No. 35,453

Drafted by

LOYD W. BONNEVILLE
Patent Attorney
1213 Amsterdam Ave.
Madison WI 53716
PH: (608) 222-7535
FAX: (608) 222-7500

APPENDIX

FACTORS BEARING UPON THE NON-OBVIOUSNESS ISSUE

Lawyers invariably cite the landmark case of Graham v John Deere, 383 U.S. 1 (1966) when considering non-obviousness issues. The following discussion comprises a summary of an even more instructive line of cases applicable to this invention.

There is often a tendency to conclude that because the differences between the articles in the prior art and an applicant's device are *simple*, that the latter is not patentable by reasons of non-obviousness. Indeed, the differences here are simple. It was held in Expanded Metal Co. v Bradford, 214 U.S. 366, 381, 29 S.Ct. 652, 53 L.Ed. 1034, 1039 and American Safety Table Co. v Schreiber, 259 F.2d 255, 263, 122 USPQ 29, 36, citing several other cases with approval, that if simplicity were a factor, "many of the most beneficial patents would be stricken down" and that simplicity of a new idea is the "truest and most reliable indication of novelty and invention, when others have devoted extensive effort and exhausted their resourcefulness in a futile search for the solution of the same vexing problem."

The criteria of Sec. 103 is with reference to a person having "ordinary skill". Factors include (1) the inventor's education, (2) problems existing in the prior art, (3) solutions offered in the prior art, (4) the rapidity with which innovation is observed in the field, (5) the sophistication of the applicable technology and (6) education of workers in the field. Environmental Designs, Ltd v Union Oil Co. of California, 713 F.2d 693, 218 USPQ 865 (1983).

Nor should it necessarily be thought an invention fails the non-obviousness test because the physical changes from the prior art it exhibits are *slight*. In Topliff v Topliff, 145 U.S. 156, 13 S.Ct. 825, 39 L.Ed. 658 (1892), the inventor merely turned links supporting the rear end of vehicle springs from

vertical to horizontal. Reversing a previous holding that the change was too “(t)rifling” to warrant a patent, the U.S. Supreme Court held that the “subject matter as a whole” had not been considered.

Even when the proffered invention appears to be a step backwards, if a previously perceived need is presently shown to be unnecessary, the decision to grant a patent should be based not upon the apparent triviality of the differences alone between the applied for invention and the prior one. In Schenck v Nortron Corporation, 719 F.2d 782, 218 USPQ 698 (1983), the invention was the substitution of one stiff piece for what had previously been an assembly of leaf springs and other pieces universally thought essential to provide damping to eliminate vibration. His invention’s return to rudimentary structure worked because, despite what others thought, damping was actually unnecessary. Chief Judge Markey characterized the lower court’s holding that the invention failed to meet the non-obviousness test as a failure to consider the “subject matter as a whole”. The case supports the proposition that an inventor may be the successful instrument of “resurrection” of that which was old and “unrecognized” by others upon illuminating the newly perceived need to them. Thus, the inventor is rewarded for insight concerning an objective or need overlooked by others even though the physical components of the invention are nothing new.

Perhaps the most enlightening case of all is that of Eibel Process Co. v Minnesota & Ontario Paper Co., 261 U.S. 45, 43 S.Ct. 322, 67L.Ed. 523 (1923). Newsprint was produced by pouring liquid pulp over a moving mesh belt. It had been observed that ripples in the paper resulted when the process was speeded up. The inventor reasoned that the speed of the belt was too fast for the liquid flow and did nothing more than tip the machine to impart a downhill flow to the liquid. Once the patent had been granted, hindsight clearly indicated that anyone familiar with the paper making process would have found it obvious to do what the inventor did. The court determined, however, that it took the inventor to show the world that the differences in speed between the liquid and the belt

was the cause of the ripples. Others had not even recognized that a problem existed but had been content to avoid ripples by running the process at the "intended" lower speed.